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Ref: Case Docket No.: P644

In Re.: Application of Mark A. Boys

Serial Number: 09/143,343

Filing Date: 08/28/1998

Title of Case: Rewind Radio and Television

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Applicant claims small entity status. See 37 CFR 1.27

**TOTAL AMOUNT OF PAYMENT** (\$ 340.00)

## Complete if Known

Application Number	09/143,343
Filing Date	08/28/1998
First Named Inventor	Mark A. Boys
Examiner Name	Thai Q. Tran
Art Unit	2616
Attorney Docket No.	P644

## METHOD OF PAYMENT (check all that apply)

Check  Credit card  Money Order  Other  None

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## FEE CALCULATION

### 1. BASIC FILING FEE

Large Entity	Small Entity	Fee Description	Fee Paid
Fee Code (\$)	Fee Code (\$)		
1001 770	2001 385	Utility filing fee	
1002 340	2002 170	Design filing fee	
1003 530	2003 265	Plant filing fee	
1004 770	2004 385	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	
<b>SUBTOTAL (1)</b>		<b>(\$)</b>	<b>0.00</b>

### 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Independent Claims	Multiple Dependent	Extra Claims	Fee from below	Fee Paid
			-20** =	X	
			-3*** =	X	
				=	

Large Entity	Small Entity	Fee Description
Fee Code (\$)	Fee Code (\$)	
1202 18	2202 9	Claims in excess of 20
1201 86	2201 43	Independent claims in excess of 3
1203 290	2203 145	Multiple dependent claim, if not paid
1204 86	2204 43	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent
<b>SUBTOTAL (2)</b>		<b>(\$)</b>

\*\*or number previously paid, if greater; For Reissues, see above

### 3. ADDITIONAL FEES

Large Entity Small Entity

Fee Code (\$)	Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for ex parte reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 420	2252 210	Extension for reply within second month	
1253 950	2253 475	Extension for reply within third month	
1254 1,480	2254 740	Extension for reply within fourth month	
1255 2,010	2255 1,005	Extension for reply within fifth month	
1401 330	2401 165	Notice of Appeal	
1402 330	2402 165	Filing a brief in support of an appeal	340.00
1403 290	2403 145	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,330	2453 665	Petition to revive - unintentional	
1501 1,330	2501 665	Utility issue fee (or reissue)	
1502 480	2502 240	Design issue fee	
1503 640	2503 320	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1806 180	1806 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 770	2809 385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 770	2810 385	For each additional invention to be examined (37 CFR 1.129(b))	
1801 770	2801 385	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	
Other fee (specify) _____			

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**SUBTOTAL (3)** **(\$)**

340.00

## SUBMITTED BY

Name (Print/Type)	Donald R. Boys	Registration No. (Attorney/Agent)	35,074	Telephone	831-726-1457
Signature			Date	10/28/2004	

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

**INVENTOR:** Mark A. Boys  
**CASE:** P644  
**SERIAL NO.:** 09/143,343                   **GROUP ART UNIT:** 2616  
**FILED:** 08/28/1998                   **EXAMINER:** Tran, Thai Q.  
**SUBJECT:** Rewind Radio and Television

**PARTY IN INTEREST:** All inventions in the disclosure in the present case are assigned to or assignable to:

Central Coast Patent Agency, Inc.

**Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450**

**DEAR SIR:**

**APPEAL BRIEF**

11/02/2004 AWONDAF1 00000082 09143343

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**37 C.F.R 1.192(c)(1) Real Party in Interest**

The real party in interest is the party named above in the caption of the brief, Central Coast Patent Agency, Inc.

**37 C.F.R 1.192(c)(2) Related Appeals and Interferences**

This is an appeal from the Office Action of the Primary Examiner dated 08/26/04, Finally rejecting claims 1-4, 17-19, 21 and 22, the only pending claims in the application. There are no related appeals or interferences in the instant case.

**37 C.F.R 1.192(c)(3) Status of the Claims**

Claims 1-16 were submitted with the original patent application USSN 09/143,343 filed on 08/28/98. Some claims were amended, others were canceled, and still others were newly presented in appellant's Amendment A, filed 6/04/2001 in response to the first non-Final action in the case mailed 12/05/00 rejecting claims 1-16. Arguments were provided in appellant's Preliminary Amendment filed 11/27/2001 in response to the Final Action mailed 08/27/01 rejecting claims 1-4 and 17-22. Further arguments were provided in appellant's Amendment C filed 2/08/2002 in response to the non-Final Action mailed 12/11/01 rejecting claims 1-4 and 17-22. Still further arguments were provided in appellant's amendment D filed 6/07/2002, in response to the Non-Final Action mailed on 04/24/02 rejecting claims 1-4 and 17-22. Further claim amendments were provided in appellant's Amendment E filed 9/25/2002 in response to the Final Action mailed 08/26/02 rejecting claims 1-4 and 17-22. Some claims were further amended, and other claims were canceled in appellant's Response F filed 2/27/2003 in response to the Non-Final Action mailed 12/04/02 rejecting claims 1-4 and 17-22. Further amendments to the independent claims were provided in appellant's Response G filed 7/03/2003 in response to the non-Final Action mailed 05/22/03 rejecting claims 1-4,

17-19, 21 and 22. Further arguments were provided in appellant's Response H, accompanying a RCE, filed 2/19/2004, in response to the Final Action mailed on 09/24/03 maintaining the rejection of claims 1-4, 17-19, 21 and 22. Further amendments to the independent claims were provided in appellant's Response, filed 6/09/2004, in response to the Non-Final Action mailed on 04/06/04 maintaining the rejection of claims 1-4, 17-19, 21 and 22. Finally a Notice of Appeal was filed by appellant on 9/23/2004, in response to the Final Action mailed on 08/26/04 maintaining the rejection of claims 1-4, 17-19, 21 and 22.

Therefore claims 1-4, 17-19, 21 and 22 are left standing for examination and have been maintained in that form until the present Appeal, which is responsive to the Final Action mailed on 08/26/04 maintaining the rejection of claims 1-4, 17-19, 21 and 22.

#### **37 C.F.R 1.192(c)(4) Status of Amendments**

Following is a chronological listing of Office Actions mailed and Responses filed in the instant case:

1. Case filed with claims 1-16 on 08/28/98, case accorded USSN 09/143,343
2. First non-Final Action mailed 12/05/01 rejecting claims 1-16.
3. Response filed 6/04/2001 as Amendment A, amending some claims, canceling other claims, and submitting some new claims.
4. Final Action mailed 08/27/01 rejecting claims 1-4, and 17-22.
5. Response to Final filed with on 11/27/2001 as Preliminary Amendment providing arguments.
6. Non-Final action mailed on 12/11/01 rejecting claims 1-4 and 17-22.
7. Response filed 2/08/2002 as Amendment C providing further arguments.
8. Non-Final Action mailed 04/24/02 rejecting claims 1-4 and 17-22.

9. Response filed with on 6/07/2002 as Amendment D providing still further arguments.
10. Final action mailed 08/26/02 maintaining the rejection of claims 1-4 and 17-22.
11. Response to Final filed with CPA on 9/25/2002 as Amendment E further amending the claims.
12. Non-Final action mailed on 12/04/02 rejecting claims 1-4 and 17-22.
13. Response filed 2/27/2003 as Response F amending some claims and canceling other claims.
14. Non-Final Action mailed 05/22/03 rejecting claims 1-4, 17-19, 21 and 22.
15. Response filed on 7/03/2003 as Response G further amending the independent claims.
16. Final action mailed 09/24/03 maintaining the rejection of claims 1-4, 17-19, 21 and 22.
17. Response to Final filed with RCE on 2/19/2004 as Response H providing arguments.
18. Non-Final action mailed on 04/06/04 rejecting claims 1-4, 17-19, 21 and 22.
19. Response filed 6/09/2004 as Response further amending the independent claims.
20. Final action mailed 08/26/04 maintaining the rejection of claims 1-4, 17-19, 21 and 22.
21. Notice of Appeal filed on 9/23/2004.

As of the time of this Appeal Brief, claims 1-4, 17-19, 21 and 22 stand for decision on appeal from the examiner's Final rejection made on 08/26/04.

#### **37 C.F.R 1.192(c)(5) Summary of the Invention**

The invention is a recording device coupled with a conventional streaming audio or audio-visual media presentation device, comprising an import port for accepting media from the media presentation device (57, Fig. 5), at least one recording mechanism (59, Fig. 5) associated with at least one data store facility having a memory (68, Fig. 5) with

capacity for recording a specific time duration of the media presentation, a user interface for controlling the function of record and for enabling functions of media transfer, store, and playback of the recorded media, an output port for enabling throughput of the media to a speaker system (69, Fig. 5) and optional visual display apparatus associated with the media presentation device, and a user input on the user interface for inserting into the recorded media at any point, and in real time during the media presentation, a first flag marking the beginning of, and a second flag marking the end of the identified media portion, the flags searchable and usable as indicia for beginning a playback session of recorded media at a desired point in the recording sequence with the playback ending at a desired point in the recording sequence with the playback ending at a desired point in the recording sequence, or for selecting a media portion of the recorded media for permanent storage.

The recording device according to a first embodiment of the present invention is exemplified in independent claim 1, which recites a recording device coupled with a conventional streaming audio or audio-visual media presentation device, wherein the recording mechanism is adapted to make a sequential, continuous-loop recording of the media presentation, such that when the memory capacity is filled, the device continues to record, overwriting the oldest recorded information, providing at any point in time a stored copy of the specific time duration of the recorded media immediately preceding the point in time.

In the first embodiment of the invention as depicted in Fig. 1, a radio (11), which is not limited to a car radio, receives radio broadcasts from an antenna (13), tunes a particular channel by well-known circuitry, and plays the tuned audio presentation over a set of speakers (15), which are typically stereo speakers. The radio (11) in this embodiment also comprises a cassette tape player 17 which may conventionally be used for playing audio tapes over speakers 15.

In some embodiments the recording device is coupled with one of an RF radio or a television, and may further comprise an analog to digital converter to, wherein the data store facility is a writeable digital memory enabled for accepting data writes comprising

digitally recorded media, and wherein the flag set denotes one of a complete song, or a block of complete songs. The result of coupling the recording device with one of an RF radio or a television, may result in internalizing the device into the circuitry of the media presentation device.

A method is provided for setting and initiating selective playback for permanent storage of media from a user-interface on the recording device coupled with a streaming audio or audio-visual media presentation device, comprising the steps of initiating sequential continuous-loop recording of a specific time period of the presentation media, identifying from the media presentation a specific media portion within the specific time period of the continuous-loop recording by inserting into the continuous-loop recording at any point and in real time during the media presentation, a first flag marking the beginning of, and a second flag marking the end of the identified media portion, activating a flag-set indicia from a user interface on the recording device, activating a recover indicia from said user interface, the recover operation for retrieving the flagged media portion, and initiating playback or media store of the flagged portion of media. In some embodiments the recording made by the recording device is a digital recording. In some other embodiments the indicia is a jogging wheel manually operated to search the flag-sets, and in still other embodiments the indicia is a memory but in that searches automatically for the flags that have been set.

### **37 C.F.R 1.192(c)(6) Issues**

Whether the Examiner in the present case makes a proper rejection of claims 18-19 and 22, as being anticipated by Tognazzini, whether a proper rejection of claims 1-4 and 17 is made as being unpatentable over Tognazzini, and whether a proper rejection of claim 21 is made as being unpatentable over Tognazzini in view of Ichinose. Appellant asserts that the prior art relied upon by the Examiner in rejecting the claims lacks motivation and fails to adequately teach or suggest the present invention as claimed.

Appellant argues that the prior art fails to disclose determining the position of the start flag at any point during the streaming audio or audio-visual media presentation.

### **37 C.F.R 1.192(c)(7) Grouping of Claims**

The claims stand or fall together, and no grouping of separately patentable claims is presented.

### **37 C.F.R 1.192(c)(8) Argument**

In the most recent Office Action mailed in the case on August 26, 2004, the Examiner reasserted the 102(e) rejection of claims 18-19 and 22 as being anticipated by Tognazzini, duplicating the prior rejection set forth previously in the Office Action mailed April 6, 2004. Appellant's prior arguments filed June 9, 2004 that the reference is provided fails to teach or suggest the present invention as claimed were not persuasive to the Examiner.

#### The Examiner's Arguments

Regarding claim 18, the Examiner has stated that the reference to Tognazzini discloses appellant's method for setting and initiating selective playback or permanent storage of media from a user-interface on a recording device coupled with a streaming audio or audio-visual media presentation device comprising all of the steps recited in the claim, including identifying from the media presentation a specific media portion within the specific time period of the continuous-loop recording by inserting into the continuous-recording, at any point and in real time during the media presentation, a first flag marking

the beginning of, and a second flag marking the end of the identified media portion.

In appellant's previous response filed June 9, 2004, the independent claims were amended to specifically recite streaming audio or audio-visual media presentations, identifying from the media presentation the specific media portion by inserting into the continuous-loop recording at any point and in real time during the presentation, the first and second flags. Appellant provided substantial arguments that the reference of Tognazzini, as is clearly recited in the abstract portion of the specification of Tognazzini, teaches, in one implementation, a decision to record a portion of audio, in this case music, from the beginning of the audio portion, or in another implementation, the decision to record a video program from the beginning, or in still another implementation, deciding to record, using a connected portable video camera, an event based on the possibility of the event happening, after the event has happened.

The Examiner has argued in response to appellant's above amendments to the independent claims and arguments presented, that Tognazzini discloses that when, during a performance of a piece of music on the radio, one decides to record the music from the beginning, and that the start-of-program pointer and the stop-pointer can be arbitrarily set using the record button and stop button. It is the Examiner's position that, therefore, Tognazzini does indeed disclose the claimed limitation of identifying the specific media portion by inserting the first and second flags into the media portion at any point in the continuous loop recording, and in real-time during the media presentation.

Appellant wishes now to focus the board's attention on the recited specific limitation of method claim 18, wherein in step (b), a specific media portion within the specific time period of the continuous-loop recording is identified from the media presentation by inserting into the continuous-recording at any point, and in real time during the media presentation, a first flag marking the beginning of, and a second flag marking the end of the identified media portion.

Appellant points out that it is clear that, in the cases of deciding to record a portion of audio, from the beginning of the audio portion, or in another implementation, the decision to record a video program from the beginning, in every case, regardless of

the program source, Tognazzini teaches that the start marker is always equal to the beginning time of the program, as determined by the programming entities of the program source, that is, the scheduled start time of the program, which is predetermined, not arbitrarily set by a beginning marker, as in the claimed invention.

The reference of Tognazzini does not and cannot determine the position of the start flag at any point during the media presentation; rather, the start point as taught in Tognazzini is identified from those presented as options. In the case of the implementation utilizing a portable camera to record an event based on the possibility of the event happening, and recording the event after the event has already happened, the teaching in Tognazzini also falls short, because the decision to identify the specific media portion worthy of recording, in this case capturing a boy's turn at bat after the boy has hit a home run, is made after the event worthy of recording, i.e. the home run. The specific media portion is therefore identified with the first and second flags only after the event to be recorded has taken place, not during the presentation of the event itself.

Tognazzini teaches, only after the beginning of the program has passed, deciding to record or store the music, video or television program, for example, from the programs beginning, which is a predetermined starting mark, and clearly not identified by the operator of the recorder user interface, as in appellant's invention. A delayed recording circuit introduces a delay between the program source and the recording device and selectively activates the recording device to record information from the source, from its beginning, after it has been delayed. The selectivity in Tognazzini of the portion of the media worthy of recording and identified by flagging, is therefore substantially compromised as compared to appellant's invention, because in Tognazzini the starting point is not settable by the user; rather, it is always set at the beginning of the program, which Tognazzini teaches is identified by comparing the output of a clock with known program start time, predetermined and published by the program source, or by receiving the program starting and/or stopping information from an external communication link. Tognazzini identifies the start point for the start flag by selecting from pre-known and predetermined program start times.

Appellant asserts that the Examiner's arguments that Tognazzini teaches the ability to arbitrarily set the start flag and end flag, anywhere in the selected media portion, in real-time during presentation of the media, clearly falls short, because the start flag for the recorded media portion is always at the beginning of the media portion, not arbitrarily set by the user anywhere in the media portion.

Tognazzini therefore clearly fails to disclose appellant's specific claim language of identifying the specific media portion by inserting the first and second flags into the media portion at any point in the continuous-loop recording, and in real-time during the media presentation. The key and patentable distinction of appellant's invention over that of Tognazzini, is that the selection of the first flag marking the beginning of the portion of the streaming audio or audio-visual media worthy of recording, may be inserted by the user of the recorder's user interface either at the beginning, or after the beginning of the media presentation, and the first flag insertion point within the continuous loop recording is completely selectable by the user, not just identified from a selection of program start times which are predetermined and published, as in the art of Tognazzini.

Appellant's independent claims clearly and specifically recite inserting into the recorded media at any point and in real-time during the media presentation, both the first and second flags. The reference of Tognazzini clearly fails to teach or suggest this specific limitation. Appellant respectfully points out to the Board that it is axiomatic that anticipation of a claim under Section 102 can be found only if the prior art reference discloses every element of the claim. *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136 138 (Fed. Circ. 1986). See also *Lindemann Maschinenfabrik GMBH vs. American Hoist and Derrick*, 730 F.2d 1452, 1458, 221 USPQ 481 485 (Fed. Circ. 1984). The art of Tognazzini clearly and unarguably fails to teach each and every limitation of applicant's independent claims, as argued above by appellant, and therefore fails as a primary reference.

In conclusion, it is respectfully submitted that the prior art submitted by the USPTO in this case, either singly or in combination, essentially fails to teach or suggest all of the limitations and capabilities as recited in appellant's claim language, and

appellant accordingly respectfully requests that the Board reverse the Final rejection of claims 1-4, 17-19, 21 and 22 and hold them allowable.

**37 C.F.R 1.192(c)(9) Appendix**

The following are the claims involved in the Appeal:

1. A recording device coupled with a conventional streaming audio or audio-visual media presentation device comprising:
  - an input port for accepting media from the media presentation device;
  - at least one recording mechanism associated with at least one data store facility having a memory with capacity for recording a specific time duration of the media presentation;
  - a user interface for controlling the function of record and for enabling functions of media transfer, store, and playback of the recorded media;
  - an output port for enabling throughput of the media to a speaker system and optional visual display apparatus associated with the media presentation device; and
  - a user input on the user interface for inserting into the recorded media at any point and in real time during the media presentation, a first flag marking the beginning of, and a second flag marking the end of the identified media portion, the flags searchable and usable as indicia for beginning a playback session of recorded media at a desired point in the recording sequence with the playback ending at a desired point in the recording sequence, or for selecting a media portion of the recorded media for permanent storage;
  - wherein the recording mechanism is adapted to make a sequential, continuous-loop recording of the media presentation, such that when the memory capacity is filled, the device continues to record, overwriting the oldest recorded information, providing at any point in time a stored copy of the specific time duration of the recorded media immediately preceding the point in time.

2. The recording device of claim 1 coupled with one of an RF radio or a television.
3. The recording device of claim 2 further comprising an analog to digital converter and wherein the at least one data store is a write able digital memory accepting data writes comprising digitally recorded media.
4. The recording device of claim 1 wherein the flag-set denotes one of a complete song, or a block of completed songs.

5-16 canceled

17. The recording device of claim 2 wherein coupling results in internalizing the device into the circuitry of the media presentation device.
18. A method for setting and initiating selective playback or permanent storage of media from a user-interface on a recording device coupled with a streaming audio or audio-visual media presentation device comprising steps of:
  - (a) initiating sequential continuous-loop recording of a specific time period of the presented media;
  - (b) identifying from the media presentation a specific media portion within the specific time period of the continuous-loop recording by inserting into the continuous-loop recording at any point and in real time during the media presentation, a first flag marking the beginning of, and a second flag marking the end of the identified media portion;
  - (c) activating a flag-set indicia from a user interface on the recording device;
  - (d) activating a recover indicia from the user interface of step (c), the recover operation for retrieving the flagged media; and
  - (e) initiating playback or media store of the flagged portion of media.

19. The method of claim 18 wherein in step (a), the recording is digital.
20. canceled
21. The method of claim 18 wherein in step (d) the indicia is a jogging wheel manually operated to search the flag-sets.
22. The method of claim 18 wherein in step (d) the indicia is a memory button that searches for the set flags automatically.

If any additional time extensions are required beyond any extension petitioned with this Appeal Brief, such extensions are hereby requested. If there are any fees due beyond any fees paid with this Appeal Brief, authorization is given to deduct such fees from deposit account 50-0534.

Respectfully Submitted,

Mark A. Boys

by Donald R. Boys

Donald R. Boys

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